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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,697	04/21/2006	Toshihisa Nakano	2006_0546A	1963

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EXAMINER	
HENRY, THOMAS HAYNES	

ART UNIT	PAPER NUMBER
3717	

NOTIFICATION DATE	DELIVERY MODE
06/15/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/576,697	NAKANO ET AL.	
	Examiner	Art Unit	
	THOMAS H. HENRY	3717	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *3/21/11*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) *1-32* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Morita (US 20010026647).

3. It is noted by examiner that as the preamble appears to be merely reciting "the use along with another game execution apparatus" which is currently not claimed in the body of the invention, and "a portable storage medium", which is not part of "a game execution apparatus" as described in claim 33. As such, the preamble is not given full patentable weight.

4. It is further noted that the read unit would need to only be capable of operating such that it is capable of requesting such data from a portable storage medium, as the portable storage medium is not positively claimed.

5. In re claim 33, Morita discloses

- A read unit operable to request and acquire the second image data from the portable storage medium (paragraphs 57-66)
- An acquisition unit operable to acquire a game program suited for use in the game execution apparatus (paragraphs 57-66)

- A game execution unit operable to execute a game in accordance with the acquired game program, generate an image from the second image data and display the generated image in accordance with progression of the game (paragraphs 57-66)

6. In re claim 34, Morita discloses an output unit operable to output display information showing a display capacity of the game execution apparatus according to a request by the portable storage medium (paragraphs 57-66)

7. In re claim 35, Morita discloses the output unit outputs, as the display information, a number of pixels of a display device in the game execution apparatus, a clock rate of a control unit in the game execution apparatus, or a data transfer rate of a bus in the game execution apparatus (as the portable device has a standard number of pixels, outputting a request for a low resolution is an effective output of a number of pixels. Even if this were not the case, it was well known in the art at the time the invention was made to output data related to data transfer, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Morita with this well known technique in order to allow for more specific information to be given to the read unit. Furthermore, it is an obvious matter of design choice to output this specific information.)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

> be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita in view of Smith et al (US 2003190952).

10. In re claims 36 and 37, Morita disclose the claimed invention except for acquiring permission information from an external server device, and a decryption key for decrypting the game which has been encrypted.

11. However, Smith discloses permission information from an external server device including a decryption key (paragraph 143, paragraph 151). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Morita with Smith in order to allow for a wider selection of games in a secure environment.

Response to Arguments

12. Applicant's arguments filed 3/21/11 have been fully considered but they are not persuasive.

13. Applicant argues that the prior art does not include the structure required by the current claims. However, the structure of the system is not positively claimed. It is noted by the examiner that applicant has claimed an *apparatus*, not a *system*, and as such, only the apparatus is required for the claim limitation, and it only needs to be capable of performing the tasks described. For some portions of applicant's claims, the prior art is not even required to be capable of performing the tasks, as the tasks are described in the preamble and are not given full patentable weight. Furthermore, the apparatus of Morita discloses

acquiring data from a portable storage device (for example paragraph 52 states "a recording medium (memory card) in which a game program for a portable game machine is stored, and to the portable game machine 250.") Even if the another gaming apparatus were claimed in the body of the claims, the gaming apparatus would need to merely be capable of reading the current device, when the two sets of image data (low resolution and high resolution) were created on another gaming apparatus. As the original location of the data conversion is inconsequential to the gaming apparatus, this limitation would be met, even given this much narrower reading of the claims.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS H. HENRY whose telephone

number is (571)270-3905. The examiner can normally be reached on M-F 9 AM - 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Melba Bumgarner can be reached on 571-272-4709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melba Bumgarner/
Supervisory Patent Examiner, Art Unit 3717

THOMAS H HENRY
Examiner
Art Unit 3717